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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,957	08/24/2001	Harald Hoeppner	3238/BDR	2134
26304	7590	01/03/2006	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP			CHEVALIER, ALICIA ANN	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	

1772

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/938,957

Applicant(s)

HOEPPNER ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005 and 12 May 1958.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/2/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **RESPONSE TO AMENDMENT**

1. Claims 1-20 are pending in the application, claims 8-18 are withdrawn from consideration.
2. Amendments to the claims, filed on October 11, 2005, have been entered in the above-identified application.

## ***REJECTIONS***

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

### ***Claim Rejections - 35 USC § 103***

4. Claims 1-5, 7, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blome (U.S. Patent No. 5,774,168) in view of Holbein et al. (U.S. Patent No. 4,596,409).

Blome discloses an identity card with an increased level of security against counterfeiting (*col. 1, lines 38-40*).

Regarding Applicant's claims 1, 19 and 20, Blome discloses a multi-layer security product (*identity card, col. 1, lines 38-40*) comprising a carrier material (*inlet layer, col. 3, line 11 and figure 2*) firmly joined to at least one coating (*intermediate layer, col. 11, line 9 and figure 2*) and at least one covering film (*surface layer, col. 3, line 16 and figure 2*) laminated to the carrier layer.

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The coating (*intermediate layer, col. 11, line 9 and figure 2*) firmly joined to the carrier material is deemed to form a thin-gauged combination of layers and consist of a laser active material that permits subsequent personalization with a laser, since the reference discloses that the intermediate layer contains a laser-produced image (*col. 3, lines 14-16*).

Blome fails to disclose that the coating is a plastic material.

Holbein discloses an identification card (*title*) marked by laser writing techniques (*col. 3, lines 27-35*). Holbein further discloses that the identification card is all-plastic because it is simpler and cheaper during production (*col. 1, lines 42-44*).

Blome and Holbein are analogous because they both discuss identification cards marked by laser writing.

It would have been obvious to one of ordinary skill in the art at the time of the invention to plastic as taught by Holbein as the laser active coating in Blome in order to simplify production. One of ordinary skill in the art would have been motivated to use plastic because it is simpler and cheaper during production (*Holbein, col. 1, lines 42-44*).

The limitations “extrusions” and “extruded onto” are method limitations and do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because the combination of Blome and Holbein discloses a plastic coating on a carrier material.

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Regarding Applicant's claim 2, the laser-active material is deemed to be excited substantially by laser radiation of a specific wavelength, since the reference discloses that the intermediate layer contains a laser-produced image (*col. 3, lines 14-16*).

Regarding Applicant's claim 3 and 4, Blome fails to disclose that the carrier material comprises paper or plastic with a security feature.

Holbein further discloses that it is necessary that the data related to the card owner and one possibility that has proved very useful in practice is the embedment of a paper inlay designed as a security print in a multilayer card. The paper inlay with its security features known in the production of security papers, such as watermarks, security threads, etc., meet the highest standards of safety and is protected against all kinds of attempted forgery (*col. 1, lines 29-41*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a paper layer as taught by Holbein as the carrier material in Blome in order to store the card owner's data/information. One of ordinary skill in the art would have been motivated to use paper because it has proved very useful in practice in a multilayer card and the with its known security features meet the highest standards of safety and is protected against all kinds of attempted forgery (*Holbein, col. 1, lines 29-41*).

Regarding Applicant's claim 5, Blome discloses that the covering film contains laser active material, since the reference discloses that the surface layer is prepared with material components or pigments that can be altered by laser beam (*col. 2, lines 7-10*).

Regarding Applicant's claim 7, the limitation "the plastic coating is imprinted after extrusion onto the carrier material" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of

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forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because the combination of Blome and Holbein discloses a plastic coating that is imprinted (*Blome, intermediate layer contains a laser-produced image, col. 3, lines 14-16*).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blome in view of Holbein as applied above, and further in view of Maurer et al. (U.S. Patent No. 4,597,592).

Blome and Holbein are relied upon as described above.

Blome and Holbein fail to disclose that the plastic coating has embossing.

Maurer discloses an identification card (*title*) marked by laser writing techniques (*col. 4, lines 16-20*). The identification card is high embossed (*col. 4, lines 3-5*). The high embossment is suitable for transferring card data onto other data carriers and provides a means for preventing both forgery and falsification of the card data (*col. 2, lines 50-68*).

Blome, Holbein and Maurer are analogous because they all discuss identification cards marked by laser writing.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Maurer high embossment in the plastic coating of the combination of Blome and Holbein in order to increase the security of the identification card. One of ordinary skill in the art would have been motivated to an embossment because it is suitable for transferring card data onto other data carriers and provides a means for preventing both forgery and falsification of the card data (*Maurer col. 2, lines 50-68*).

***ANSWERS TO APPLICANT'S ARGUMENTS***

6. Applicant's arguments in the response filed May 12, 2005 regarding the 35 U.S.C. 103 rejections over Blome in view of Holbein and further in view of Maurer of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the prior art of record fails to disclose that the carrier and the plastic coating are joined together by extrusion. Applicant further argues that the resulting bond is significantly stronger than other possible structures, such as laminate structures, as detailed in the discussion of the prior art in the specification.

The method of forming a product does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents *evidence* from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Also, Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration. MPEP 2145. Furthermore, Applicant specification does not have any examples in the specification to support their statement.

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Applicant argues that the declaration makes clear the present inventive structure is stronger and more secure against counterfeiting.

The Declaration of Mr. Detlef Martens and Michael Radtke is deemed to be unpersuasive since it is merely stating Mr. Martens and Mr. Radtke's opinion. In order for a declaration to be persuasive it must provide examples clearly evidencing Applicant's statements.

The declaration states in paragraph #11 "We determined through testing and confirmatory trails that extrusion of a plastic coating that was to be used as the personalized layer provided the strongest bond." However, they fail to actually supply the data or a written description of the testing trails. Applicant should present this *evidence* so that the Examiner can examine the data and reasonably conclude that the claimed product differs in kind from those of the prior art.

Applicant's samples are unpersuasive for the same reason that the declaration is unpersuasive. A description of the test trails and any pertinent data regarding the trails has not been included.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37



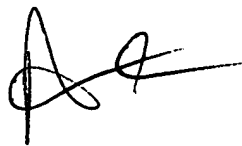
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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12/26/05



ALICIA CHEVALIER  
PRIMARY EXAMINER